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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161373
Party	Plaintiff American Italian Pasta Company ,
Correspondence Address	Thomas H Van Hoozer Hovey Williams LLP 2405 Grand Blvd, Ste 400 Kansas City, MO 64108
Submission	OPPOSER'S MOTION FOR LEAVE TO FILE AMENDED NOTICE OF OPPOSITION
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Date	05/06/2005
Attachments	Motion to Amend Notice of Opposition.pdf (3 pages) Amended Notice of Opposition.pdf (6 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA
COMPANY

Opposer,

v.

BARILLA G. E R. FRATELLI-SOCIETA
PER AZIONI,

Applicant.

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OPPOSITION NO.: 91-161,373
SERIAL NO.: 78/136,703
MARK: BARILLA - AMERICA'S
FAVORITE PASTA

OPPOSER'S MOTION FOR LEAVE TO FILE AMENDED NOTICE OF OPPOSITION

Opposer, American Italian Pasta Company ("AIPC"), hereby moves the Board for an order permitting it to file an Amended Notice of Opposition pursuant to Rule 15(a) Fed. R. Civ. P., 37 C.F.R. §2.107, TBMP § 507.02, to include additional allegations that registration of Applicant's alleged mark, BARILLA - AMERICA'S FAVORITE PASTA, should be denied insofar as Applicant, at the time of filing its application, did not have a bona fide intention, under circumstances showing the good faith of such person, to use the mark in commerce. Subsequent to Opposer's filing of its Notice of Opposition on July 21, 2004, Opposer has obtained additional information and evidence regarding Applicant's intent to adopt and use the trademark, BARILLA - AMERICA'S FAVORITE PASTA. In support of Opposer's Motion, Opposer notes that additional grounds for the opposition set forth in the proposed Amended Notice of Opposition are based on information revealed as a result of the discovery responses from Applicant.

Pursuant to the Federal Rule of Civil Procedure 15(a) leave to amend shall be freely given when justice so requires. "The Board has granted leave to amend pleadings with

considerable liberality where the amendment does not violate settled law and the circumstances are such that the adverse party is not prejudiced thereby.” Beth A. Chapman, *The Trademark Reporter*, Vol. 81, May - June 1991, 305 (legal citations omitted).

Opposer submits that permitting it to amend its Notice of Opposition will not prejudice Applicant and, that this motion is timely insofar as the additional claims are based on information and evidence adduced recently through the discovery process. No additional discovery is needed by Applicant regarding this issue, as Applicant is in possession, custody and control of the witnesses and documents it needs to address the allegations concerning its own intent in filing the trademark application at issue.

Further, since the Board proceeding is still in the pre-trial state, prior to any testimony having been taken by Opposer in its testimony period, leave to amend should be allowed. See, e.g., *Space Base, Inc. V. Stadis Corp.*, 17 USPQ2d 1216 n1 (TTAB1990). By allowing Opposer to amend its Notice of Opposition, the Board is permitting full adjudication of the merits in this dispute. See Chapman, *supra*, at 306 (“The fact that the adverse party may be prejudiced as a result of the delay to the proceedings is generally outweighed by the principal that there should be full adjudication.”).

Applicant attaches hereto a copy of the proposed amended pleading pursuant to TBMP § 507.01.

WHEREFORE, Opposer respectfully requests that this Board grant this Motion for Leave to File the attached Amended Notice of Opposition.

Dated: May 6, 2005

Respectfully submitted,

/s/ Thomas H. Van Hoozer
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CERTIFICATE OF SERVICE

I hereby certify that on the 6th day of May, 2005, I served the foregoing document by causing a true copy thereof to be sent via first class, postage paid, to the following:

Carla Calcagno
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005

/s/ Thomas H. Van Hoozer

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA COMPANY,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91161373
)	
BARILLA ALIMENTARE S.p.A.)	
)	
)	
Applicant.)	

AMENDED NOTICE OF OPPOSITION

In the matter of Application Serial No. 78/136,703, filed June 18, 2002, in the name of Barilla Alimentare S.p.A., published for opposition in the Trademark *Official Gazette* of March 23, 2004 for the mark BARILLA - AMERICA'S FAVORITE PASTA, American Italian Pasta Company (hereinafter referred to as "Opposer") believes that it would be damaged by registration of the mark shown in said application and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Opposer, American Italian Pasta Company, is a corporation organized under the laws of the State of Missouri having a principal place of business at 4100 N. Mulberry Drive, Kansas City, Missouri 64116-1696.
2. Applicant, Barilla Alimentare S.p.A., is, on information and belief, a company organized under the laws of Italy, having a business address at Via Mantova 166, Parma PR, Italy 43100 (hereinafter referred to as "Applicant"). Applicant has

appointed G. Franklin Rothwell, Esq., 1425 K Street, NW Suite 800, Washington, D.C., 20005 as its domestic representative upon whom notice or process in the proceedings affecting the mark may be served.

3. Opposer and/or its predecessors in interest (hereinafter collectively referred to as "Opposer") have continuously used the trademark AMERICA'S FAVORITE PASTA since at least as early as September of 1997 for pasta, and from a date prior to the filing date or the claimed date of first use of the opposed application serial number 78/136,703. In addition, Opposer's predecessor in interest first began using the mark AMERICA'S FAVORITE on its packaging in the 1950's.
4. Opposer has filed applications for registration of the marks AMERICA'S FAVORITE PASTA (word mark) as application serial number 76/497,489 on March 14, 2003 and AMERICA'S FAVORITE PASTA and design as application serial number 76/497,190 on March 14, 2003. Both of these marks recite the goods as "pasta" and have been in continuous use and recite a claimed date of use prior to the filing date of the opposed application serial number 78/136,703.
5. Since the first use of the mark AMERICA'S FAVORITE PASTA in 1997, Opposer and its predecessor in interest have spent substantial sums of money in advertising and promoting its pasta products sold under the AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA and design marks.
6. As a result of the substantial marketing efforts of Opposer and its predecessor in interest and length of use, its efforts to protect its right to use the mark AMERICA'S FAVORITE PASTA, and its substantial sales of products bearing the marks AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA and design,

the mark AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA and design have become distinctive of opposer's pasta goods since before the filing date or first date of use of Applicant's mark.

7. Notwithstanding Opposer's prior rights in and to the aforesaid distinctive AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA and design marks, on June 18, 2002, Applicant filed an application for registration of a mark consisting of the terms BARILLA - AMERICA'S FAVORITE PASTA under Section 1(b) for "pasta, pasta products, sauces for pasta" in International Class 30 as Application Ser. No. 78/136,703.
8. During prosecution of said application, Applicant amended the identification of goods to "pasta, pasta products, namely, meals consisting primarily of pasta, macaroni salad, pasta salad, sauces for pasta" and entered a disclaimer of the words "AMERICA'S FAVORITE PASTA" apart from the mark as a whole. Application Ser. No. 78/136,703 was published in the *Official Gazette* on March 23, 2004.
9. Application Ser. No. 78/136,703 has been cited against Opposer's Application Ser. No. 76/497,489 and 76/487,190 and as a result, Opposer has been unable to secure registration of its marks AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA and design. Applicant's BARILLA - AMERICA'S FAVORITE PASTA mark is so substantially similar to Opposer's AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA marks adopted and used by Opposer and its predecessors in interest since a date long prior to Applicant's filing date that it is likely to cause confusion, or reverse confusion, as to the source, sponsorship

or affiliation as to the user by the purchasing public as to the source of goods sold under the mark.

10. Applicant has previously registered the mark BARILLA as shown, for example, in Reg. No. 2,005,752 for pasta, and thus granting Applicant registration of the mark BARILLA - AMERICA'S FAVORITE PASTA is not calculated to protect Applicant's Barilla trademark but to prevent others from use or registration of the portion of the mark AMERICA'S FAVORITE PASTA contrary to Opposer's prior rights therein.
11. Applicant's BARILLA - AMERICA'S FAVORITE PASTA designation so resembles Opposer's prior and aforesaid AMERICA'S FAVORITE PASTA Marks as to be likely, when used in connection with the services of Applicant, to cause confusion or reverse confusion, or mistake or to deceive customers, thereby resulting in damage and detriment to Opposer, its AMERICA'S FAVORITE PASTA Marks, and its right to enjoy exclusive use and registration thereof.
12. The goods identified in the opposed application are the same or so similar and/or related to the goods sold by Opposer under its AMERICA'S FAVORITE PASTA Marks, and, upon information and belief, Opposer and Applicant engage in, and/or will engage in, the sale and promotion of their respective goods through the same and/or similar channels of trade, and/or to the same general class of purchasers.
13. Upon information and belief, members of the relevant trade and public are likely to be confused, mistaken or deceived as to the origin, sponsorship, and/or association of Opposer's goods rendered under Opposer's AMERICA'S FAVORITE PASTA Marks, and misled into believing that such goods emanate from, or in some way, directly or indirectly, are associated with and/or endorsed by Applicant if Applicant

is granted the right to register the mark BARILLA - AMERICA'S FAVORITE PASTA with its presumption of exclusive right to use said mark, to the damage and detriment of Opposer, its goodwill and reputation.

14. Upon information and belief, the application to register the mark of Applicant, namely, BARILLA - AMERICA'S FAVORITE PASTA, was submitted with notice and knowledge of the prior rights and use of Opposer's AMERICA'S FAVORITE PASTA Marks in connection with pasta products.
15. Further, the Applicant, at the time of filing its application, did not have a bona fide intention, under circumstances showing the good faith of such person, to use the mark in commerce.
16. To allow registration of the mark BARILLA - AMERICA'S FAVORITE PASTA for the goods identified in the subject application serial number 78/136,703 to Applicant in view of the prior rights of Opposer would cause damage to Opposer and to the reputation and goodwill it enjoys in its AMERICA'S FAVORITE PASTA Marks for pasta.
17. For the reasons set forth above, Opposer, by this Notice of Opposition, opposes the registration by Applicant of the mark BARILLA - AMERICA'S FAVORITE PASTA and therefore requests that this opposition be sustained.

WHEREFORE, Opposer prays that registration of Application Serial No. 78/136,703 be denied as filed and published and Applicant adjudged not entitled to registration of the mark BARILLA - AMERICA'S FAVORITE PASTA. If any additional fee is due in connection with the filing of this Notice of Opposition, it may be charged to Deposit Account 19-0522.

Respectfully submitted,

AMERICAN ITALIAN PASTA COMPANY

By its attorneys,

/s/ Thomas H. Van Hoozer
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Kansas City, Missouri 64108
816/474-9050

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on the 6th day of May, 2005, I served the foregoing document by causing a true copy thereof to be sent via first class, postage paid, to the following:

Carla Calcagno
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005

/s/ Thomas H. Van Hoozer